

REMARKS

Claims 14-27 are pending in this application. Claims 39-52 are withdrawn from consideration as being directed to a non-elected invention. Applicant respectfully requests favorable reconsideration and allowance in light of the remarks contained herein.

I. Restriction Requirement

Applicant notes that a restriction requirement has been made between i) claims 14-27; ii) claims 39-46; and iii) claims 47-52. The restriction requirement states that claims 14-27 were constructively elected since an Office Action on the merits has been received for the originally presented invention.

Applicant respectfully submits that the restriction requirement is improper. Applicant notes that the only reasons for a serious burden being present that appears to apply is due to the fact that the claim groups are in the same class, but fall into different subclasses of search. However, Applicant submits that this does not pose any additional burden on examination in light of the overlap in subject matter of dependent claims in each of the claim groups. In fact, a search of the subject matter within the groups has already been made in examination of the present application.

For example, each claim group contains common issues regarding interactions between local and remote postage accounts in the independent claims. Additionally, Examiner has previously searched for art to reject claims 22-23 which are directed to a postage dispensing kiosk. These claims present issues common to group 2, which is directed to a postage kiosk. Further, additional subject matter of group 1 has already been searched which is common to group 3. For example, claims 14 and 50 are directed to a postage evidencing method and device configured to communicate with a plurality of vendors. Accordingly, each claim group contains common issues that have been, and will be, addressed in the examination of constructively elected group 1. Thus, it cannot be said that examining the separate claim groups creates a “serious burden” on the Examiner. Accordingly, Applicant submits that the restriction requirement is improper.

II. Rejection Under 35 U.S.C. § 103

A. Pierce in view of Willoughby

Claims 14-18, 20-21 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,151,591 to Pierce et al. (hereinafter “Pierce”) in view of International Patent No. WO 02/093498 to Willoughby, et al. (hereinafter “Willoughby”). However, as outlined below, Applicant respectfully submits that the proposed combination is improper for multiple reasons. As such, Applicant requests that the rejection be withdrawn.

1. The Office Action Fails to Assert a *Prima Facie* Case of Obviousness Because the Asserted Reason to Combine References is Improper

Claim 14 recites “configuring the local postage evidencing device to communicate with a plurality of vendors providing access to a plurality of remote postage accounts.” The Office Action admits that Pierce fails to teach this limitation and relies on Willoughby to remedy this deficiency. The Office Action states as its reasoning to combine that “it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the invention to incorporate...Willoughby so that a user can select another vendor if a particular remote postage provider suffers downtime.”

Applicant notes that in making an obviousness rejection, reasoning should be identified that shows “what may have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR v. Teleflex*, 550 US. __ (2007). If these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. *Id.* at __; MPEP 2143. Because proposed reasons for combining the prior art references fails to show what may have prompted a person of ordinary skill in the relevant field to combine the elements, and no such reasoning can be found without using impermissible hindsight, Applicant submits that the above rejection is improper.

The foregoing reason for combining the references set forth in the Office Action contains multiple flaws. For example, as acknowledged by the Examiner, Pierce does not teach any remote vendors. Hence, there is no remote vendor that could be suffering downtime, and therefore there is no reason to add functionality to Pierce to allow for switching between remote vendors. Additionally, there is no reason that the network of

Pierce would need to add any additional “down time” compensation. Pierce explicitly discloses that “each client PC has access, if authorized, to both its own local PSD(s), if any, and any other client PSD(s) in the network.” Col. 3 ll. 31-33. In other words, in Pierce, the network components are in communication with each other. Therefore there would no need to add communication abilities to compensate for down time of a component because such abilities are already present. Hence, one with skill in the art would not have found it obvious pursuant to 35 U.S.C. §103 to combine Pierce and Willoughby “so that a user can select another vendor if a particular remote postage provider suffers downtime.”

2. When Examining the Prior Art as a Whole, it is Clear that Pierce and Willoughby Cannot be Properly Combined and that the References Fail to Teach the Claims of the Present Application

The disclosure of Pierce teaches a completely divergent type of postage metering solution than that of Willoughby, each designed to present a complete solution for two completely different issues. Applicant notes that in examination, ascertaining the differences between the prior art and the claims at issue requires considering both the invention and the prior art references as a whole. MPEP 2141.02 (emphasis added). When viewing the cited references as a whole, it is clear that they cannot be readily combined by one with skill in the art. Further, even if one could combine the cited art, the combination would still fail to teach the claims of the present application.

Pierce teaches a network system such as one that would be distributed throughout an office, or multiple offices, of a company. *See* Pierce Col. 3 ll. 20-34. This network system is designed to communicate with multiple postage metering devices that are set forth as nodes in the network, in order to either take advantage of the geographic location of other devices and/or to efficiently utilize money resources already owned by the owners of the network. *See* Pierce FIG 1; Col. 5 l. 14 – Col 6 l. 10. Willoughby, on the other hand, discusses a software tool which facilitates a user in utilizing an online shipping API system. *See* Willoughby FIG 1 item 130; [0016]. The shipping system API receives the request for postage, conducts the transaction with a PC vendor, provides all metering services for the system (i.e. no local meters are deployed, communicated with, etc.), and records the transaction. *Id.* at [0028], [0030], and [0033]. As can be readily seen, these disparate

teachings cannot simply be thrown together because the actual results of such a combination would be unclear.

If the teachings of Pierce and Willoughby were attempted to be combined, the functionality of Willoughby would be a misplaced appendage on the network of Pierce, and would provide both redundant and conflicting functionality. As a result, one with skill in the art could not readily integrate these systems. For example, all transaction processing of Pierce is implemented by a central network server in the network. *See* Pierce Col. 6 ll. 6-9. If one with skill in the art were to combine Willoughby to provide multiple vendors, they must also add the functionality of the shipping system API in order to establish communication with the vendor system. However, the shipping system API, which is necessary to facilitate interaction with multiple vendor systems, itself administers transaction processing. As such, the proposed combination would add redundant and conflicting transaction processing features. These redundancies, and the conflicting operation provided thereby, would avert one with skill in the art from making the proposed combination. Further, separate transaction processors would frustrate the “centralized approach concerning transaction accounting” which is taught in Pierce.

Additionally, the refilling process that Examiner relies on as teaching “reducing a balance on the remote postage account without transferring the value of the postage amount to the local account” could not be carried out with the remote accounts in Willoughby because the algorithms of Willoughby would cause the shipping system API (which is required in order to connect to remote account vendors) to subvert the functionality of the local PSD of Pierce. Willoughby explicitly describes a postage transaction process, e.g. a request is received at the shipping system API to request a postage label and determines the postage rate, the shipping system API retrieves the proper funds from a PC postage vendor, and the shipping system API then generates the label. *See* Willoughby [0032]-[0033]. Whereas Pierce accesses account funds on a separated PSD, while metering is calculated and printed at a local PSD. *See* Pierce Col. 4 ll. 15-21. As such, the vendors of Willoughby would not function as a part of the network of Pierce because when a local PSD is attempting to utilize a remote account’s funds, the shipping system API of Willoughby would attempt to meter the postage (which is the task of the local PSD of Pierce). This functionality would also prevent the remote account of Willoughby from transferring money to a device, such as a

PSD of Pierce. As shown above, when funds are deducted from a remote vendor account of Willoughby, the shipping system API meters the postage corresponding to such funds. Hence, the funds could not be transferred to the local PSD.

Therefore, the proposed combination is also improper because it would frustrate the principle metering operations of Pierce, e.g. it would not allow funds transfers, and would disrupt Pierce's methods for transaction accounting. *See In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (stating if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious); *see also In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification).

Moreover the proposed combination could not function as set forth in the claimed invention. Claim 14 recites “reducing a balance on the remote postage account without transferring the value of the postage amount to the local account.” The Office Action relies on the teachings of Pierce for this limitation. However, it is noted that the remote postage account recited in the claim is “administered by a selected vendor of said plurality of vendors.” In other words, in order to reject claim 14, the balance reduction teachings of Pierce, which utilizes money from a separate PSD, must necessarily work with what the Office Action relies on as remote accounts administered by vendors (of which the Office Action relies on Willoughby as teaching). However, as shown above, the proposed combination prevents such functionality because the shipping system API of Willoughby would attempt to carry out functions of the PSD requesting the funds. Therefore, Examiner cannot rely solely on Pierce for teaching the above recited limitation, and any combination with Willoughby would not create the claimed limitation.

As a result, Applicant respectfully submits that the proposed combination is improper at least because it can not be properly combined by one with skill in the art. Additionally, the proposed combination would not function as required by the claims. Accordingly, Applicant respectfully requests withdrawal of the present rejection.

Claims 18, 20-21 and 24-27 depend either directly or indirectly from independent claim 14, and thus, inherit each and every limitation of their corresponding independent claim. As a result, claims 18, 20-21 and 24-27 are allowable for at least the reasons set forth above. Further, dependent claims 18, 20-21 and 24-27 contain aspects that are patentable in their own right.

B. Pierce in view of Willoughby in further view of Lee

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of Willoughby applied to claim 14 above, further in view of U.S. Patent No. 5,742,683 as to Lee et al. (hereinafter "Lee"). Claim 19 depends from independent claim 14, and thus, inherits each and every limitation of its corresponding independent claim. As a result, claim 19 is allowable for at least the reasons set forth above.

C. Pierce in view of Willoughby in further view of Eddy

Claims 22 and 23 and rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of Willoughby as applied to claim 14 above, further in view of U.S. Patent No. 5,812,400 as to Eddy et al. (hereinafter "Eddy"). Claims 22 and 23 depend from independent claim 14, and thus, inherit each and every limitation of their corresponding independent claim. As a result, claims 22 and 23 are allowable for at least the reasons set forth above.

CONCLUSION

In view of the above, Applicant believes the pending application is in condition for allowance and respectfully requests favorable reconsideration.

Applicant believes no fee is due with this response. However, if a fee is due, please charge any fees required or credit any overpayment during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees to Deposit Account No. 06-2380, under Order No. 61135/P024US/10303362 from which the undersigned is authorized to draw.

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Respectfully submitted,

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